

REMARKS

The Office Action mailed November 2, 2006, has been carefully reviewed and the foregoing amendments have been made in consequence thereof.

Claims 1, 2, and 4-20 are now pending in this application. Claims 5-20 are rejected. Claims 1, 2 and 4 are allowed. Claims 5, 6, 7, 9, 10, 11, 13, 14, 15, 17, 18, 19 and 20 are amended herein. No new matter has been added.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 since the Amendment: (a) places the Application in condition for allowance for the reasons discussed herein; (b) does not raise any new issue requiring further search and/or consideration as the Amendment relates to issues previously discussed throughout the prosecution; (c) satisfies the requirement of form asserted in the Office Action; (d) does not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) places the application in better form for appeal, should an appeal be necessary. The amendments herein are necessary and were not earlier presented because they are made in response to arguments raised in the final Office Action. Entry of this amendment is also respectfully requested.

Applicants wish to thank the Examiner for courtesies extended to Applicants' representative, Kevin McDermott, during a telephone interview conducted on January 30, 2007. During the interview, independent Claims 5 and 14 were discussed. No agreement was reached regarding patentability of the pending claims.

Applicants greatly appreciate the Examiner's indication that Claims 1, 2 and 4 are allowed and that Claims 12 and 19 contain allowable subject matter.

The rejection of Claims 5-20 under 35 U.S.C. § 112, second paragraph, is respectfully traversed.

The Office Action asserts on page 2 that it is not clear how one of Applicant's projections can extend radially. Specifically, the Office Action asserts that the plurality of projections extend radially, but one projection alone does not. Claims 5 and 14 have been amended to recite, "a plurality of raised projections." Accordingly,

Applicants submit that Claims 5 and 14, as amended, satisfy Section 112, second paragraph.

For the reasons set forth above, Applicants respectfully request that the Section 112 rejections of Claims 5 and 14 be withdrawn.

The rejection of Claims 5-11, 13-18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Fisher et al. (U.S. Patent No. 6,005,314) in view of Admitted Prior Art (APA) and Story et al. (U.S. Patent No. 3,787,014), and further in view of Boede et al. (U.S. Patent No. 4,933,809) is respectfully traversed.

Fisher et al. describe an air switch housing (96) that is positioned within a motor shell (56), and an air switch boss (94) that extends from the air switch housing through a motor shell opening (62) (column 6, lines 16-19). The air switch boss is threaded, and a nut (102) is threadably engaged to the air switch boss and tightened against a shell (56) (column 6, lines 19-20).

APA describe a plurality of mounting hardware or fasteners (20) that are attached to a shell outer surface (16) and extend radially outwardly from the shell outer surface (page 3, lines 3-5). More specifically, the fasteners are spaced circumferentially around a housing (10), and are welded to the shell outer surface (page 3, lines 5-7).

Story et al. describe a replacement motor (52) that differs from a plurality of original equipment motors employed in inside-out type air conditioning units in that it comprises a stationary outer housing (54) (column 3, lines 4-7). A replacement motor mounting (50) is completed by a plurality of fasteners (66) which are received in a plurality of fastener receiving holes (5) of the replacement motor and in either a plurality of fastener receiving holes (62) or a plurality of fastener receiving holes (64) of a bracket (58) to secure the motor to the bracket (column 3, lines 27-39).

Boede et al. describe a plurality of cover mounting holes (56) (column 4, lines 49-53). The cover mounting holes on an interior surface of a cover are recessed and each includes a bottom flange (57), the underside of which bears on the top of an

interior cover mounting boss (28) as a mounting screw (52) or bolt is threaded into the boss (column 4, lines 49-53). The cover covers a box including a plurality of components for interconnection of a plurality of external input/output leads supplying power to and from an assembly (column 2, lines 16-20). Boede et al. also describes in column 4, lines 53-58, a recess (58) eliminating mounting bolt head protrusion above the surface of the cover. Similarly, the cover mounting holes (60) on the edge of the cover (47) are located in U-shaped recesses (61) to suitably recess the heads of the mounting screws (52).

Claim 5 recites a motor housing configured to receive a motor extending between a pair of endshields, the housing comprising: “an inner surface...an outer surface, said inner surface configured to extend between a rotating component of the motor and said outer surface...a housing body extending between said inner surface and said outer surface, said body comprising a thickness...a plurality of raised projections extending radially outwardly from at least one of said housing inner surface and said housing outer surface defining a recess with respect to said housing inner surface of the housing body including an assembly of the rotating component and a stator of the motor, each of said plurality of raised projections comprising at least one opening extending therethrough, each of said plurality of raised projections comprising an inner surface and a thickness equal to said housing body thickness...and at least one fastener having a top surface, said at least one fastener extends outwardly through said housing opening such that said top surface is substantially co-planar with an un-recessed portion of said housing inner surface.”

None of Fisher et al., APA, Story et al., nor Boede et al., considered alone or in combination, describe nor suggest a motor housing as recited in Claim 5. Specifically, neither Fisher et al., APA, Story et al., nor Boede et al., considered alone or in combination, describes nor suggests a motor housing configured to receive a motor extending between a pair of endshields including a plurality of raised projections extending radially outwardly from at least one of a housing inner surface and a housing outer surface defining a recess with respect to the housing inner surface of the housing body including an assembly of a rotating component and a stator of the motor, each of the plurality of raised projections includes at least one opening

extending therethrough, each of the plurality of raised projections includes an inner surface and a thickness equal to a housing body thickness. Rather, in contrast to the present invention, Fisher et al. describes a nut that is threadedly engaged to an air switch boss and tightened against a shell. APA describes a plurality of fasteners that are spaced circumferentially around a housing, and are welded to the shell outer surface. Story et al. describes a plurality of fasteners which are received in a plurality of fastener receiving holes of a replacement motor and in a plurality of fastener receiving holes of a bracket to secure the motor to the bracket. Boede et al. describe a mounting screw or bolt that is threaded into a boss located within a box including a plurality of components for interconnection of a plurality of external input/output leads supplying power to and from an assembly. Moreover, Boede describes a recess (58) eliminating mounting bolt head protrusion above the surface of the cover, and, similarly, the cover mounting holes (60) on the edge of the cover (47) are located in U-shaped recesses (61) to suitably recess the heads of the mounting screws (52). Accordingly, for at least the reasons set forth above, Claim 5 is submitted to be patentable over Fisher et al. in view of APA, and Story, and in further view of Boede et al.

Claims 6-11 and 13 depend from independent Claim 5. When the recitations of Claims 6-11 and 13 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-11 and 13 likewise are patentable over Fisher et al. in view of APA and Story et al., and further in view of Boede et al.

Claim 14 recites “a motor comprising: a pair of endshields...a housing extending between said endshields and including an assembly of a stator and a rotor, wherein said housing includes a plurality of raised projections extending outwardly from said housing, said housing comprising an outer surface, an opposite inner surface, and a body extending therebetween, said body comprising a thickness, each of said plurality of raised projections defining a recess with respect to said housing inner surface and comprising an inner surface and a thickness equal to said housing body thickness, at least one opening extending through said recess, and at least one fastener having a top surface, said at least one fastener extends radially outwardly through said housing such that said top surface is substantially co-planar with said

inner surface, wherein said housing inner surface extends between said stator-rotor assembly and said housing outer surface.”

Fisher et al., APA, Story et al., and Boede et al. are described above.

Neither Fisher et al., APA, Story et al., nor Boede et al., considered alone or in combination, describes nor suggests a motor as recited in Claim 14. Specifically, neither Fisher et al., APA, Story et al., nor Boede et al., considered alone or in combination, describes nor suggests a motor including a housing extending between endshields and including an assembly of a stator and a rotor, wherein the housing includes a plurality of raised projections extending outwardly from the housing, the housing including an outer surface, and opposite inner surface, and a body extending therebetween, the body including a thickness, each of said plurality of raised projections defining a recess with respect to the housing inner surface and including an inner surface and a thickness equal to the housing body thickness, at least one opening extending through the recess, and at least one fastener having a top surface, the at least one fastener extending radially outwardly through the housing such that the top surface is substantially coplanar with the inner surface. Rather, in contrast to the present invention, Fisher et al. describe a nut that is threadedly engaged to an air switch boss and tightened against a shell. Story et al. describe a plurality of fasteners which are received in a plurality of fastener receiving holes in a replacement motor and in a plurality of fastener receiving holes of a bracket to secure the motor to the bracket. Boede et al. describe a mounting screw or bolt that is studded into a boss located within a box including a plurality of components for interconnection of a plurality of external input/output leads supplying power to and from an assembly. Moreover, Boede et al. describe a recess (58) eliminating mounting bolt head protrusion above the surface of a cover, and, similarly, the cover mounting holes (60) on the edge of the cover (47) are located in U-shaped recesses (61) to suitably recess the heads of the mounting screws (52). Accordingly, for at least the reasons set forth above, Claim 14 is submitted to be patentable over Fisher et al. in view of APA and Story et al., and further in view of Boede et al.

Claims 15-18 and 20 depend from independent Claim 14. When the recitations of Claims 15-18 and 20 are considered in combination with the recitations of Claim 14, Applicants submit that dependent Claims 15-18 and 20 likewise are patentable over Fisher et al. in view of APA and Story et al., and further in view of Boede et al.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is improper. As is well-established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentives supporting the combination. Neither Fisher et al, APA, Story et al, nor Boede et al., considered alone or in combination, describes nor suggests the claimed invention. Further, in contrast to the Examiner's assertions within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Fisher, et al., APA, Story et al. and Boede et al. because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggest to combine the disclosures, other than Applicant's own teaching.

Moreover, if "art" teaches away from a claimed invention, such a teaching supports the nonobviousness of the invention. The case is U.S. v. Adams, 148 U.S.P.Q. 479 (1966); Gillete Co. v. S.C. Johnson and Son, Inc., 16 U.S.P.Q. 2nd 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, applicants respectfully submit that Boede, et al. teaches away from the present invention and from Fisher et al., and as such, thus supports the non-obviousness of the present invention. More specifically, in contrast to the present invention and to Fisher, et al., Boede et al. clearly describes a recess (58) eliminating mounting bolt head protrusion above the surface of the cover, and, similarly, the cover mounting holes (60) on the edge of the cover (47) are located in U-shaped recesses (61) to suitably recess the heads of the mounting screws (52). Because Boede, et al. describes suitably recessing the heads of the mounting screws (52), Boede et al. teaches against the top surface of a fastener being substantially coplaner with an

unrecessed portion of the housing inner surface. Moreover, because Boede et al. teaches away from the claimed invention, there is no suggestion nor motivation to provide the tops of the fasteners substantially co-planar with an inner housing surface.

The Office Action asserts that "one would have been motivated to reduce manufacturing costs by providing a recess having a height that sufficiently receives the fastener head and can be formed by using a limited amount of material and further since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art." However, the invention does not change the size of a feature. Thus, the statement of motivation is improper.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Further, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejections are based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejections appear to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an

attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejections of the claims be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejections of Claims 5-20 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Kevin McDermott", is written over a horizontal line.

Kevin McDermott

Registration No.: 48,113

ARMSTRONG TEASDALE LLP

One Metropolitan Square, Suite 2600

St. Louis, Missouri 63102-2740

(314) 621-5070